

REMARKS

The claims have been amended to correct the dependency of some of the dependent claims. Applicant submits that no new subject matter has been introduced into the application as a result of the foregoing amendments.

In the Restriction Requirement of August 5, 2004, the Examiner has asserted that the claims are directed to two distinct inventions:

- I. Claims 1-24, drawn to a "Method of electronically executing a commercial transaction", purportedly classified in Class 705, subclass 64; and
- II. Claims 25-39, drawn to a "Method for the dissemination of information to a mobile electronic user device based upon the device location", purportedly classified in class 705, subclass 26.

The Restriction Requirement alleges that Inventions I and II are related as purportedly distinct subcombinations disclosed as usable together in a single combination. Without addressing the merits of the Restriction Requirement, Applicant hereby elects to prosecute the invention of Group I and corresponding claims 1-24 at this time.

The Restriction Requirement also alleges that the application contains claims directed to species of the claimed invention that are purportedly patentably distinct:

Species I: Figures 1-3C and 6-8

Species II: Figure 4

Species III: Figure 5

The Restriction Requirement requests that Applicant elect one of the identified species, and list all claims readable thereon. While Applicant disagrees with the Restriction Requirement's identification of purportedly-distinct species, for ease of reference, the terms "Species I", "Species II" and "Species III" as used herein will refer to the Restriction Requirement's identification of the purported species, without accrediting any conclusion that the identified species are distinct or properly subject to election.

Species I (Figures 1-3C and 6-8) generally provides for the electronic execution of a commercial transaction. Species II (Figure 4) also provides for the electronic execution of a commercial transaction, adding encryption and decryption of the transaction code that is also transmitted in Species I. Species III (Figure 5) illustrates another implementation of the electronic execution of a commercial transaction, in which the transaction code comprises telephone dial sequence and the telephone dial sequence is transmitted over a telephone network.

Applicant submits that Species II is not an independent and distinct species subject to restriction from Species I. Species II illustrates an additional element (not an alternative element) that can be incorporated into the embodiment of Species I. Specifically, Species I involves the transmission of a transaction code (Figure 2, step 220). Species II also involves the transmission of such a code (Figure 4, step 420) in an environment analogous to that of Species I, with the addition of the encryption of the code before transmission (Figure 4, step 415) and the subsequent decryption of the code after transmission (Figure 4, step 425). Accordingly, what has been identified as

Species I and Species II are not in fact distinct species, but rather Species II is a species of the broader genus that is Species I.

That Species I and Species II are not distinct species is further illustrated by consideration of the claims. Claim 1 is directed squarely to Species I. The only claims directed to Species II are claims 7 and 8 – both of which are ultimately dependent upon generic claim 1. Thus, claim 1 is clearly generic to both Species I and Species II. At a minimum, even if Species I and Species II are ultimately deemed independent and distinct, claim 1 is a linking claim such that restriction should not be required.

Likewise, Species III is not an independent and distinct species subject to restriction from Species I, but is rather a specific application of the invention of Species I. Species III is directed to an implementation in which the transaction code of Species I is comprised of a telephone dial sequence. The specific elements of Figure 5 illustrate details of the Species I order process that are specifically directed to the Species III context of a dial sequence transaction code. For example, compare Figure 2 of Species I to Figure 5 of Species III. Each features an order selection step, namely, steps 210 and 510, respectively. Transmission of the transaction code in step 220 is analogous to the dialing of a vendor order line in step 520, during which the telephone dial sequence "transaction code" is transmitted. The verification of the User ID and security code in steps 230, 240 and 260 is analogous to the detection and confirmation of the caller number in steps 530, 540 and 550. Both implementations also involve the subsequent order processing, in steps 250 and 570.

That Species I and Species III are related and not properly subject to restriction is further illustrated by consideration of the claims. Claims 1 and 18 are both directed to Species I. However, claims 2, 19 and 20 are clearly directed to Species III, and yet they are dependent upon claim 1 of Species I. As with Species II, Species III is merely a specific embodiment of the broader invention of Species I. Also, even if Species III is ultimately deemed independent and distinct from Species I, Applicant submits that claims 1 and 18 are linking claims such that restriction should not be required.

Additionally, Applicant notes that even where related inventions are distinct, in order to justify restriction the Examiner must show (A) separate classification of the inventions; (B) separate status in the art; or (C) different fields of search. (MPEP § 808.02.) In this case, none of the above showings have been made with respect to Species I, II and III. Moreover, Applicant submits that Species I, II and III share the same classification status in the art and field of search.

For the reasons stated above, Applicant respectfully submits that the identification of three purportedly independent and distinct species is improper, and that Applicant need not elect a single one of the identified Species I, II and III for examination. Applicant further submits that at least claim 1 is generic to Species I and Species II, and at least claims 1 and 18 are generic to Species I and Species III.

Nonetheless, should the Examiner uphold the requirement to elect one of the identified species, Applicant hereby elects Species I without acknowledging the requirement for election as being proper. Applicant submits that at least the following claims read on Species I: claims 1, 2-6, 9-18 and 21-24.

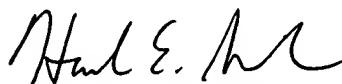
Appln. No. 09/966,223
Amendment and Communication
Response to Restriction Requirement of August 5, 2004

Should anything further be required, a telephone call to the undersigned, at (312) 456-8400, is respectfully invited.

Respectfully submitted,

GREENBERG TRAURIG, LLP

Dated: October 5, 2004


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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail postage pre-paid under 37 C.F.R. § 1.8 in an envelope addressed to ATTN: Box Response, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on October 5, 2004.


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